THE FINAL FRONTIER: RIGHT OF PUBLICITY IN FICTIONAL CHARACTERS

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The right of publicity secures an individual’s right “to control the commercial value and exploitation of his name and picture or likeness and to prevent others from unfairly appropriating this value for their commercial benefit.” The author of this note advocates granting a right of publicity in a fictional character to an actor who portrays the fictional character, to the extent that the fictional character is so closely coupled with the actor that the character’s use evokes the identity of the actor.

After examining the social, economic, and preemption debates surrounding right of publicity claims, the author determines that the courts are correctly deciding that the right should include a general “appropriation of identity” test. Despite this judicial success, the author demonstrates that, currently, there is a lack of uniform legislation protecting the right of publicity. The author outlines the benefits that would follow the enactment of a federal statute protecting the right of publicity, and, in conclusion, the author encourages the application of an analytical framework to determine whether infringement of the actor’s right of publicity took place.

I. INTRODUCTION

Beam me up, Scotty!2
Fascinating . . . 3

Captain James T. Kirk, First Officer Spock, Dr. Leonard “Bones” McCoy, Chief Engineer Montgomery Scott, Uhura, Sulu, Chekov—the intrepid crew of the Starship Enterprise. From our television sets each week, they flew daring missions to “strange, new worlds . . . to seek out new life and new civilizations . . . to boldly go where no man has gone be-

* I would like to thank Professor Peter B. Maggs for his invaluable critique and suggestions.
2. “Beam me up, Scotty” is the rallying cry of Star Trek fans everywhere. See WILLIAM SHATNER & CHRIS KRESKI, GET A LIFE! (cover) (1999). Star Trek and related marks are trademarks of Paramount Pictures. Gene Roddenberry is the creator of Star Trek.
3. For the benefit of those who do not “grok Spock,” “fascinating” was his standard response to any puzzling situation.
They launched America’s enduring fascination with science fiction, spawned three spin-off television series, nine motion pictures, and passed from mere popularity to cult phenomenon.\footnote{4} Another recognized phenomenon is that modern society is “celebrity-driven,” in that famous personalities can greatly influence the American public.\footnote{5} Recognizing the marketing potential of this influence, advertisers often capitalize on it to sell products via clever advertisements designed to associate the products in the minds of consumers with the stars and the characters they portray.\footnote{7} The more popular the celebrity, the greater the consumer recognition, the greater the market value of that celebrity’s identity, and the greater the temptation to exploit it for profit. However, the law of the right of publicity “protects the celebrity’s sole right to exploit [the] value” of her identity.\footnote{8} Because it is easy to evoke the identities of the most popular celebrities “without resorting to obvious means such as name, likeness, or voice,” the right of publicity law has evolved into a general prohibition against misappropriation of identity.\footnote{9}

To illustrate the concept, let us return to the final frontier of Star Trek. The individual stars who played the famous crew—William Shatner, Leonard Nimoy, DeForest Kelly, James Doohan, Nichelle Nichols, George Takei, and Walter Koenig—are known and loved by millions of Americans by virtue of having portrayed their respective Star Trek characters. Such widely recognized personas are very valuable, and very tempting, to advertisers, but the stars’ names, likenesses, and voices are protected from unauthorized use by the right of publicity. In other words, promotion of the “William Shatner Toupee” without Shatner’s permission is prohibited because it uses Shatner’s name to promote a product. But what if someone were to run a commercial featuring a strikingly beautiful, dark-skinned woman, dressed in a replica of the familiar red uniform worn by Nichelle Nichols in her role as Uhura, to promote feminine hygiene products for “the woman of the future?” The commercial never mentions Nichols’ name, however, and the woman does not look enough like Nichols that one would actually confuse the two. Would Nichols have a cause of action under the right of publicity

\footnote{5} See Shatner & Kreski, supra note 2, at 61–98 (describing the evolution of the Star Trek convention phenomenon and overwhelming fan response); see also The Official Star Trek Web Site, at http://www.startrek.com (last visited Mar. 25, 2000). Paramount’s elaborate Star Trek website evidences the show’s continuing enjoyment of a large and loyal audience.
\footnote{6} See generally Howard Rosenberg, Celebrity Advocates: Is It Their Role? It May Be the Actor’s On-Screen Persona That Sells in the Marketplace of Ideas, L.A. TIMES, Nov. 5, 1990, at F1 (discussing the influence celebrities wield over the American audience).
\footnote{7} See id. (describing how consumers associate the attributes of fictional characters with the actors who portray them).
\footnote{8} White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992).
\footnote{9} Id.
against the product’s sponsor and its advertising agency for their use of her identity via the fictional “Uhura” character? If so, then what are the limits of the control that a celebrity may exert over the use of a fictional character she has portrayed? For example, could William Shatner and Leonard Nimoy have sued Saturday Night Live for John Belushi and Chevy Chase’s parody of their “Kirk” and “Spock” characters?

This note will examine the issues surrounding these questions and demonstrate that an actor should have a right of publicity in a fictional character to the extent the character is so closely associated with the actor that its use evokes the actor’s identity. Part II will define the right of publicity by tracing its legal origins and probing the outer limits of its scope. Part III will examine the raging social, economic, and preemption debate over that scope and show that the courts correctly determined that the right should include a general “appropriation of identity” test. Part IV will attempt to demonstrate that the right of publicity is applicable to fictional characters and suggest a method of analysis for determining infringement that would exempt such fair uses as parody.

II. THE RIGHT OF PUBLICITY DEFINED

A. Legal Origin of the Doctrine

The right of publicity is commonly defined as the “right of an individual, especially a public figure or a celebrity, to control the commercial value and exploitation of his name and picture or likeness and to prevent others from unfairly appropriating this value for their commercial benefit.” The doctrine evolved from the more basic right to privacy, described in an 1890 article by Louis Warren and Samuel Brandeis as the “right to be let alone.”


11. See William L. Prosser, Privacy, 48 Cal. L. Rev. 383, 389 (1960). “Dean Prosser delineated four distinct types of the right of privacy: (1) intrusion upon one’s seclusion or solitude, (2) public disclosure of embarrassing private facts, (3) publicity which places one in a false light, and (4) appropriation of one’s name or likeness for the defendant’s advantage.” Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 834 (6th Cir. 1983). The fourth evolved into the separate and distinct right of publicity. See id.

12. Samuel D. Warren & Louis D. Brandeis, The Right to Privacy, 4 Harv. L. Rev. 193, 195 (1890) (quoting Judge Cooley). The authors’ explicit intent was only to establish a separate and dis-
Judge Jerome Frank coined the modern phrase “right of publicity” in 1953 and defined it as “the right [of a man] in the publicity value of his likeness.” Judge Frank took great pains to distinguish the fledgling right from the right of privacy, explaining that it was based not on a desire to be free from publicity, but rather a desire to capitalize on publicity. Consequently, the right to privacy is reserved to the common man, and foreclosed to prominent persons; the celebrity must look instead to the right of publicity to protect his proprietary interests in his identity.

In the next six decades, the right of publicity achieved wide recognition in the courts and among commentators. The Supreme Court and almost half the states explicitly recognize the right at common law, and almost as many states have codified the right. In addition, the Right of Publicity: Towards a Federal Statute?

*See* id. at 200, 211. Previously, a cause of action for an injunction of such unauthorized publication rested on breach of confidence or implied contract, but that was inadequate because it could provide no relief against a stranger. *See* id. at 211. In contrast, Warren and Brandeis advocated “rights as against the world.” *Id.* at 213.

13. Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953) (holding that a man has a right in the publicity value of his likeness that “might be called a ‘right of publicity’”).

14. *See* id. at 868; *see also* Carson, 698 F.2d at 834. As Judge Frank explained in *Haelan Laboratories*, “many prominent persons (especially actors and ball players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements or popularizing their countenances, displayed in newspapers, magazines, buses, trains and subways.” *Haelan Labs.*, 202 F.2d at 868.


18. *See* Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 576 (1977). Zacchini is the Court’s only right of publicity case to date. The Zacchini Court upheld a “human cannonball” performer’s right of publicity over the defendant television broadcasting station’s First Amendment privilege to gather and disseminate news items. *See* id. at 577–78. In reaching its decision, the Court was heavily influenced by the fact that the television station filmed and aired the performer’s entire act when, presumably, a shorter clip would have been sufficient to convey the news to the public. *See* id. at 574–75. The right of publicity is not limited to appropriation of a performer’s entire act, however. E.g., White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1398 (9th Cir. 1992) (setting a general “appropriation of identity” standard for the right of publicity).


20. *E.g.,* CAL. CIV. CODE §§ 3344, 3344.1 (West 1997 & Supp. 2000). Section 3344 prohibits unauthorized use of a person’s name, voice, signature, photograph, or likeness, in any manner, for commercial purposes. Section 3344.1 prohibits similar use of a deceased person’s name, voice, signature, photograph or likeness. The Ninth Circuit has construed the listed indicia of personality quite literally, with the result that the statute does not offer as broad a protection as afforded by common law.
statement (Second) of Torts\textsuperscript{21} and the Restatement (Third) of Unfair Competition\textsuperscript{22} include it as a cause of action. Courts treat the right of publicity as a true property right:\textsuperscript{23} it is transferable (via license or assign-ment)\textsuperscript{24} and descendible.\textsuperscript{25} Remedies for infringement or misappropriation include injunction and damages,\textsuperscript{26} including punitive damages.\textsuperscript{27}

Courts routinely recognize infringement of the right for misappropriation of such accepted identifying characteristics as name, likeness, signature, or nickname.\textsuperscript{28} However, some courts have expanded the right further by upholding plaintiffs’ right of publicity claims absent use of these acknowledged indicia of persona. The next section discusses some of those cases and the controversy they have elicited regarding the proper scope of the right of publicity.

B. Outer Limits of the Doctrine

Courts often resort to the right of publicity to protect celebrity identities and prevent a defendant’s unjust enrichment when traditional trademark, unfair competition, or right to privacy claims fail.\textsuperscript{29} In striving for fairness and equity, some courts have expanded the right well beyond the traditionally recognized right to control the commercial exploitation

\textbf{E.g.}, White, 971 F.2d at 1397 (holding that a robot with mechanical features was not a “likeness” of Vanna White within the meaning of § 3344); Midler v. Ford Motor Co., 849 F.2d 460, 462-63 (9th Cir. 1988) (finding no cause of action under § 3344 because the infringer used an imitation of Midler’s voice rather than Midler’s actual voice and because “likeness” means only visual representation and does not include vocal imitation). In both White and Midler, however, the Ninth Circuit permitted plaintiffs’ causes of action under the California common-law right of publicity. See White, 971 F.2d at 1397–99; Midler, 849 F.2d at 463–64.


22. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995). Section 46 states that “[o]ne who appropriates the commercial value of a persona’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules stated at § 48 and § 49.” Id.


24. See id. at 1354–44 (explaining that the right of publicity is “capable of being disassociated from the individual and transferred by him for commercial purposes”); see also MCCARTHY, supra note 10, §§ 10.3–4.


29. See generally Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (vacating dismissal of plaintiff’s complaint and remanding for determination of right of publicity, after rejecting unfair competition, federal and state law trademark claims, and refusing to decide right to privacy).
of name or likeness. This section discusses those most controversial cases that have succeeded in expanding the right beyond its traditional boundaries.

Although one of the cases discussed here is from the Third Circuit, the remainder are from the Court of Appeals for the Ninth Circuit. Because the area is the seat of the entertainment industry, many celebrity plaintiffs bring right of publicity cases in the California federal district courts. The cases then percolate their way up to the Ninth Circuit, on appeal. The Ninth Circuit’s widely proclaimed expansive treatment of publicity rights has earned it nicknames such as the “Court of the Stars”\(^{30}\) and the “Court of Appeals for the Hollywood Circuit.”\(^{31}\)

In the early case of *Motschenbacher v. R. J. Reynolds Tobacco Co.*,\(^{32}\) the Ninth Circuit expanded the right of publicity to include “an appropriation of the attributes of one’s identity.”\(^{33}\) The court held that the unauthorized use of a picture of a well-known professional race car driver’s distinctively marked car sufficiently identified plaintiff and thus, his identity was misappropriated, even though the features of the driver in the commercial were unrecognizable.\(^{34}\) The court based its reasoning on the ground that the markings on the car were unique to plaintiff and, therefore, “caused some persons to think the car in question was plaintiff’s and to infer that the person driving the car was plaintiff.”\(^{35}\) Note that here defendants were liable for *commercially* exploiting a celebrity’s identity.\(^{36}\)

In *Midler v. Ford Motor Co.*,\(^{37}\) the Ninth Circuit again expanded the list of activities prohibited by the right of publicity to include the use of

\(\text{References}\):

32. 498 F.2d 821 (9th Cir. 1974).
33. Id. at 824; see also Carson, 698 F.2d at 837. In Carson, the Court of Appeals for the Sixth Circuit expanded the right of publicity to include anything that is “generally associated with a popular entertainer.” Id. at 832. The court upheld night-show host Johnny Carson’s claim for violation of the right of publicity when defendant advertised the portable toilets he rented and sold as the “Here’s Johnny” portable toilets. See id. at 833. Although defendant did not use Carson’s name or likeness, the court held that he had commercially exploited Carson’s identity when he adopted the phrase that had long been used to introduce Carson on *The Tonight Show*, even though Carson himself had not been the one to speak the phrase. See id. at 832, 836, 838. The court explained its reasoning as follows:

The right of publicity, as we have stated, is that a celebrity has a protected pecuniary interest in the commercial exploitation of his identity. If the celebrity’s identity is *commercially* exploited, there has been an invasion of his right whether or not his “name or likeness” is used. Carson’s identity may be exploited even if his name, John W. Carson, or his picture is not used. *Id.* at 835 (emphasis added). The distinction between commercial exploitation to sell a product and noncommercial use (even as a product, such as a newspaper, which generates profit) is a critical point that will be elaborated upon throughout this note.

34. See Motschenbacher, 498 F.2d at 826–27.
35. *Id.*
36. See *id.*
37. 849 F.2d 460 (9th Cir. 1988).
“sound-alikes.” Bette Midler, a famous diva, was imitated by a sound-alike singing “Do You Want to Dance,” a song taken from one of Midler’s albums and one of her most famous hits. Although the advertising agency had obtained a license from the copyright holder of the song, the court upheld Midler’s publicity claim because defendants “used an imitation to convey the impression that Midler was singing for them . . . in order to sell a product.” The Ninth Circuit returned to its theory of “impression” in the highly controversial case, White v. Samsung Electronics (White I).

The White I court explicitly stated that the right of publicity was not limited to name or likeness and adopted an expansive “appropriation of identity” test. In White I, Samsung and its advertising agency ran a series of advertisements depicting cultural items in humorous situations set in the future. The advertisement that offended White depicted a robot dressed in a blonde wig, long gown, and prominent jewelry selected to resemble White’s own hair and dress, but its features were mechanical and did not resemble White’s. The robot stood next to a Wheel of Fortune game board in White’s signature pose. A caption read: “Longest-running game show. 2012 A.D.”

The three-member panel upheld summary judgment against White for her claim under the California statutory right of publicity because the statute provided protection only for the unauthorized use of a person’s likeness. The court explained that the robot was, at most, a “caricature or impressionistic resemblance.” However, the panel reversed summary judgment against White’s common-law right of publicity reasoning that the common law had expanded to include appropriation of identity by impersonation. In rejecting defendant’s parody defense, the

38. See id. at 461.
39. Id. at 463 (emphasis added).
40. See White v. Samsung Elecs. Am., Inc., 971 F.2d 1395 (9th Cir. 1992) (White I). I refer to this case herein as “White I” to distinguish it from Judge Alex Kozinski’s later dissent from the denial for rehearing en banc. See White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1512 (9th Cir. 1993) (Kozinski, J., dissenting) (White II). I refer to Kozinski’s dissent as “White II.”
court again emphasized that its decision applied only to instances where advertisers exploit celebrities to sell products.51

In yet another robot case, a different three-member panel of the Ninth Circuit strengthened the holding in White I by explicitly adopting its “impressionistic resemblance” test in Wendt v. Host International, Inc.52 Wendt I arose from a dispute between plaintiffs George Wendt and John Ratzenberger, former stars of the television sitcom Cheers, and Host International, the licensee of the Cheers copyright.53 In spite of plaintiffs’ objections, Host placed robots, allegedly resembling the actors, in airport bars modeled after the Cheers set.54 The district court dismissed plaintiffs’ claims on the ground that the robots resembled Wendt and Ratzenberger only in body type—one was slight, the other was heavy; the facial features were “totally different.”55 The panel, however, found an issue of material fact whether the robots resembled plaintiffs sufficiently to merit a cause of action and reinstated plaintiffs’ claim.56 The court noted that infringement depended on whether a jury found that defendants had commercially exploited the stars’ identities to increase profits for their bars.57

McFarland v. Miller,58 a case from the Court of Appeals for the Third Circuit, is the only case thus far to explicitly recognize the right of publicity in a fictional character portrayed by an actor. The McFarland court used an association test to determine whether the plaintiff George McFarland owned a right of publicity in the character “Spanky.”59 McFarland had portrayed “Spanky” in the Our Gang and Little Rascals series.60 Defendant Miller owned a restaurant that he named “Spanky McFarland’s,” where he displayed photos and murals of the Little Rascals and Our Gang, including McFarland, and referenced the “Spanky” character several times in the menu.61 Noting that defendant’s very act of using plaintiff’s name and likeness demonstrated its commercial value,62 the Third Circuit found that the district court improperly granted summary judgment.63 The court articulated the following test: “Where an actor’s screen persona becomes so associated with him that it becomes

51. See id. at 1410.
52. 125 F.3d 806 (9th Cir. 1997) (Wendt I). I refer to this case as “Wendt I” to distinguish it from Judge Alex Kozinski’s dissent from the denial for rehearing en banc. See Wendt v. Host Int’l, Inc., 197 F.3d 1284, 1285–89 (9th Cir. 1999) (Kozinski, J., dissenting) (Wendt II). I refer to Kozinski’s dissent to Wendt I as “Wendt II.”
53. See Wendt I, 125 F.3d at 809.
54. See id.
55. See id.
56. See id. at 811.
57. See id.
58. 14 F.3d 912 (3d Cir. 1993).
59. See id. at 921.
60. See id. at 914.
61. See id. at 916.
62. See id. at 922.
63. See id.
inseparable from the actor’s own public image, the actor obtains an interest in the image which gives him standing to prevent mere interlopers from using it without authority.”

The cases discussed above show that the courts are increasingly likely to allow a right of publicity claim whenever the defendant has somehow evoked an individual’s persona for commercial advertising to promote a product, including use of a fictional character with which the celebrity is intimately associated. However, a vocal minority of judges and commentators vigorously oppose the recent expansion of the right of publicity to include almost any indicia of identity. The next section examines this conflict between the majority and minority views.

III. THE DEBATE OVER THE RIGHT OF PUBLICITY: MAJORITY VERSUS MINORITY

The Ninth Circuit elicted a storm of controversy over its expansive application of the right of publicity, with Judge Alex Kozinski and Professor Michael Madow leading the rebellion. In 1993, six months after the White I decision, the California Law Review published Professor Madow’s seminal article, Private Ownership of Public Image: Popular Culture and Publicity Rights, which criticized the justifications traditionally offered for publicity rights. Shortly thereafter, the Ninth Circuit denied the petition for an en banc rehearing of White I, and Kozinski cited Madow’s article in his scathing dissent from that denial, White II. In that opinion, Kozinski described the White I decision as “bad law” and the Ninth Circuit’s expansive “appropriation of identity” test as “very dangerous” because it allowed the removal of too much information from the public domain.

The controversy rages on. The Ninth Circuit closed out 1999 by denying the petition for an en banc rehearing of Wendt I, and Kozinski ushered in the new millennium by again roundly criticizing the majority for its liberal position in his no less stinging dissent, Wendt II. Kozinski reiterated his free speech argument, but focused primarily on the pre-emption issue—what he deems an impermissible interference of publicity rights with the rights of copyright owners.

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64. McFarland v. Miller, 14 F.3d 912, 920 (3d Cir. 1994); accord Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 832, 835 (6th Cir. 1983) (expanding the right of publicity to include anything “generally associated with a popular entertainer”).


66. See White v. Samsung Elecs. Am., Inc., 989 F.2d 1512 (9th Cir. 1993) (denying the petition for en banc rehearing without opinion) (Kozinski, J., dissenting) (White II).

67. See id. at 1516 n.19 (Kozinski, J., dissenting).

68. Id. at 1513–14, 1516.

69. See Wendt v. Host Int’l, Inc., 197 F.3d 1284, 1284 (9th Cir. 1999) (denying the petition for an en banc rehearing without opinion) (Kozinski, J., dissenting) (Wendt II).

70. See id. at 1285.

71. See id. at 1286.
This section presents the justifications for the right of publicity, the minority’s primary criticisms, and rebuttal to those criticisms. Part A examines the noneconomic, or social, issues, while part B examines the economic issues, with one exception. Part C examines that exception—the potential conflict between the right of publicity and copyright law.

A. Social Debate over the Right of Publicity

The most viscerally appealing noneconomic argument in support of the right of publicity is the Lockean natural rights theory that one is entitled to the fruit of one’s labor. As the Ninth Circuit noted, “[c]onsiderable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit.” It follows then that celebrities are entitled to exclusive control of their personas by virtue of the personal effort they invest in achieving celebrity status.

Judge Kozinski and Professor Madow attempt to discredit the use of Lockean theories to justify the right of publicity on the ground that a celebrity’s identity is not solely her own creation—others such as writers, directors, producers, the news media, and even the audience, participate in the process. In White I, the Ninth Circuit clearly recognized this as an accurate representation of the celebrity identity, but flatly rejected the contention that participation by others justified denying the celebrity exclusive control of this jointly crafted identity. The court stated, “[t]elevision and other media create marketable celebrity identity value... The law protects the celebrity’s sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.” Kozinski and Madow’s argument is more thoughtfully rebutted by Roberta Rosenthal Kwall. Kwall writes that “regardless of the input from others, celebrities still remain the vehicles through which their images are conveyed to the public.”

Celebrity image can include fictional characters because often “the actor playing the character is the most direct link to the character in the public’s mind.” As noted by Justice Bird in her dissent to Lugosi v.


73. White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992) (White I). But see Coombe, supra note 17, at 369 (contending that celebrities are entitled only to the value they personally add to the star image, not to the entire value of that image). Yet, Coombe admits, “[c]learly, individual labor is necessary if the persona is to have value and we could not appreciate stars without their expenditure of effort.” Id. at 369.

74. See White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1517 (9th Cir. 1993) (Kozinski, J., dissenting) (White II); see also Madow, supra note 10, at 189–96.

75. See White I, 971 F.2d at 1399.

76. Id.

77. Kwall, supra note 15, at 42.

78. Id. at 44.
Universal Pictures, many actors may portray a character, while only one will imbibe it with that certain something that animates it and transforms it into legend. Justice Bird realized that often “public recognition generated by [a particular actor's] performance” creates the value in the character. Thus, an actor does engage in the type of value additive conduct contemplated by Locke and is entitled to a property interest in a fictional character insofar as the public so intimately associates him with that character that the character essentially becomes an aspect of his public identity.

Closely associated with the labor theory is the concept that the right of publicity includes a “personhood” component. Roberta Rosenthal Kwall and Alice Haemmerli contend that a personhood interest derives from Hegelian and Kantian theories that “private property is an extension of human personality.” Control of human personality and, by extension, private property, is “essential to human dignity.” Recognition of the personhood interest restores to the right of publicity the

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79. 603 P.2d 425 (Cal. 1979) (in bank). Bela Lugosi is known for having portrayed that most famous vampire, Count Dracula, in three Universal Pictures movies: Dracula, Dracula’s Daughter, and Abbott and Costello Meet Frankenstein. See id. at 434–35. Even though others played “Dracula” before and after Lugosi, it was Lugosi’s likeness that the public has most generally associated with the Count. See id. at 425 n.3, 445. However, during his lifetime, Lugosi never commercially exploited his name or likeness, nor tried to prevent anyone else from doing so. See id. at 428. Four years after Lugosi’s death, Universal began licensing his likeness as “Count Dracula” for use on merchandise such as T-shirts, model figures, and masks. See id. at 435. Lugosi’s widow and son, the beneficiaries of his will, filed suit seeking an injunction and damages for the unauthorized commercial use of Lugosi’s likeness. See id. at 434. Lugosi spawned three separate opinions. The majority held that Lugosi’s heirs were not entitled to a right of publicity in his name or likeness because (1) he had not exercised the right during his lifetime, and (2) even if he had, the right would have been personal to him and not descendible. See id. at 429. The dissent and concurrence frame one of the central points of contention in the modern debate over the validity of the right to publicity. Chief Justice Bird, in her dissent, took the view that has since been expanded upon by commentators such as Roberta Rosenthal Kwall, see infra notes 83–89 and accompanying text, that an actor brings to the roles he plays something entirely unique unto himself. See id. at 444–45. Justice Mosk, on the other hand, takes the contrary view, in his concurrence, that actors merely play roles that are created primarily by the efforts of others, such as screenwriters and directors. See id. at 432–33. Any contribution by the actor is de minimis. See id. Mosk’s view has been adopted and expanded upon by right of publicity critics such as Judge Kozinski and Professor Madow. See supra note 74 and accompanying text.

80. See Lugosi v. Universal Pictures, 603 P.2d 425, 444–45 (Cal. 1979) (in bank) (Bird, C.J., dissenting); see also Kevin S. Marks, An Assessment of the Copyright Model in Right of Publicity Cases, 70 CAL. L. REV. 786, 787 (1982).

81. Lugosi, 603 P.2d at 435. While Justice Bird referred primarily to economic value, her reasoning applies equally well to social and cultural value, for a fictional character attains cultural significance only if it is known to society.

82. JOHN LOCKE, THE SECOND TREATISE OF CIVIL GOVERNMENT AND A LETTER CONCERNING TOLERATION 15 (J.W. Gough ed., 1946) (stating that each person has a property right in himself, and that whatever he removes from nature with his own labor also becomes his own property).

83. This term is borrowed from Justin Hughes. See Justin Hughes, The Personality Interest of Artists and Inventors in Intellectual Property, 16 CARDozo ARTS & ENT. L.J. 81, 81 (1998).

84. See Kwall, supra note 15.

85. See Haemmerli, supra note 17.

86. Kwall, supra note 15, at 39; see also Haemmerli, supra note 17, at 411–22 (discussing Kantian philosophy and the right of publicity).

moral underpinnings it lost in the evolution from personal to property right and properly credits it as “a freedom-based property right with both moral and economic characteristics.” Such an “autonomy-based” right can provide relief not only for economic injury, but also for moral injury that may occur when a celebrity’s identity is misappropriated.

Although largely ignored by critics, the courts have recognized and endorsed this moral component of publicity rights. In *Waits v. Frito-Lay, Inc.*, the Ninth Circuit upheld a jury award of punitive damages to singer Tom Waits because “the appropriation of the identity of a celebrity may induce humiliation, embarrassment, and mental distress.” The court acknowledged separate injury to Waits’ future publicity value (economic injury) and goodwill (reputational injury) and awarded damages for each. Similarly, the court in *Grant v. Esquire, Inc.*, noted that plaintiff Cary Grant could recover “for any lacerations to his feelings that he may be able to establish,” in addition to the fair market value of the use of his identity. As these cases illustrate, the law recognizes the moral right of celebrities to control the commercial exploitation of their identities and provides redress for injury to their reputations. This aspect of the law of the right of publicity is justified because a celebrity, like any other person, has a personhood interest in her own identity and suffers a loss of dignity when denied control of that identity.

However, no matter what the interest, a celebrity’s control of his identity cannot be absolute, for the right of publicity recognizes fair use exceptions to infringement. One such exception is the metaphorical use of celebrity identity. Celebrity personas are social constructs that

88. See Michael J. Higgins, *A Pitch for the Right to Publicity*, 155 N.J. L.J. 8 (1999) (“By elevating the right of publicity to intellectual property status, the proponents of the right left it supported only by commercial, nondignitary interests.”).

89. *Id.* at 1103. Frito-Lay used a sound-alike of Wait’s voice in an advertising campaign, despite its knowledge of Wait’s policy against doing commercials due to his belief that participation in commercial advertising detracts from an artist’s integrity. See *id.* at 1097.

90. *See id.* at 1104.

91. 367 F. Supp. 876 (S.D.N.Y. 1973) (finding a cause of action when *Esquire* magazine published an advertisement depicting Cary Grant’s head superimposed on a clothing model’s torso). Like Waits, Grant did not endorse products. See *id.*

92. *Id.* at 881.

93. *See id.* at 1093 (9th Cir. 1992).

94. 978 F.2d 1093 (9th Cir. 1992).

95. *Id.* at 1104.

96. *But see Cardtoons v. Major League Baseball Players Ass’n*, 95 F.3d 959, 976 (10th Cir. 1996) (“Publicity rights, however, are meant to protect against the loss of financial gain, not mental anguish.”).


98. *See id.* at 1449 (holding that the right of publicity is precluded by the first-sale defense).
Celebrities and the characters they portray can enter society’s stream of consciousness by becoming metaphors for concepts, pregnant with imagery and meaning. These metaphors can then be used as a kind of shorthand code for communicating the thoughts and ideas imbedded within them. To use one of Professor Madow’s examples: When President Ronald Reagan was questioned about a comment he made that Saddam Hussein was “going to get his ass kicked,” in the Gulf War, he didn’t say a word, just hitched up his pants as John Wayne often did when unwisely challenged by some villain on the silver screen. By evoking “The Duke” and the hyper-macho roles for which he is famous, Reagan was able to convey an explicit meaning without further explanation. As one court put it, “celebrities [and the characters they portray] are an important part of our public vocabulary.”

Kozinski and Madow fear that giving celebrities exclusive control over their identities via the right of publicity will impoverish the public domain by limiting their metaphorical use, thus imposing a significant burden on the public that is not balanced by any comparable benefit. Kozinski expressed this fear in White II by claiming that the majority expanded the right without bounds and shifted the balance between the individual’s interests and the public’s interests significantly in favor of the individual: “Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to anything that reminds the viewer of her.” Kozinski argued that the majority had created a new and vague “appropriation of identity” claim without the necessary limitations, such as the fair use doctrine, placed upon other intellectual property rights.

99. Welkowitz, supra note 41, at 84; see also Stephen King, The Girl Who Loved Tom Gordon (1999) (author’s postscript) (“The impression fans have of people who have achieved some degree of celebrity are always fictional, as I can attest of my own personal experience.”) (emphasis in original).

100. See Madow, supra note 10, at 142–43 (“[S]tar images are widely used in contemporary American culture to create and communicate meaning and identity.”).

101. See id., at 128 (“[C]elebrity images are thus important expressive and communicative resources: the peculiar, yet familiar idiom in which we conduct a fair portion of our cultural business and everyday conversation.”); see also David B. Feldman, Finding a Home for Fictional Characters: A Proposal for Change in Copyright Protection, 78 CAL. L. REV. 687, 690 (1990).

102. See Madow, supra note 10, at 128.

103. Cardtoons v. Major League Baseball Players Ass’n, 95 F.3d 959, 972 (10th Cir. 1996) (citing Madow, supra note 10, at 128 (John Wayne illustration)).

104. See White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1513–14 (9th Cir. 1993) (Kozinski, J., dissenting) (White II); Madow, supra note 10, at 134.

105. White II, 989 F.2d at 1515.

106. See id. at 1516. Likewise, Judge Cornelia Kennedy, in her dissent to Carson, claimed that the majority had extended the right of publicity “to include phrases or other things which are merely associated with the individual.” Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831, 837 (6th Cir. 1983) (Kennedy, J., dissenting). For a description of the case, see infra note 111. She expressed a fear similar to Judge Kozinski’s that such extension would “permit a popular entertainer or public figure, by associating himself or herself with a common phrase, to remove those words from the public domain.” See Carson, 698 F.2d at 837. For additional insight into Judge Kozinski’s conception of the fair
Madow argues this burden may be even higher on marginal groups within society who “re-code” the metaphors to meet their different needs. For example, some lesbian communities have adopted the James Dean “bitter brat . . . against the whole boring suburban middle class” look in a unique expression of gender identity. As Madow comments, “the right of publicity facilitates top-down management of popular culture and constricts the space available for alternative and oppositional cultural practice.” In other words, he fears that celebrities will exercise their right of publicity by censoring any use of their personas that they deem offensive or tasteless.

Although the minority’s First Amendment concerns are credible and not to be dismissed casually, one realizes they are less justified when viewed in light of the case law. The Ninth Circuit has consistently stated

use defense to intellectual property rights, see New Kids on the Block v. News Am. Publ’g Inc., 971 F.2d 302 (9th Cir. 1992). In New Kids, two national newspapers conducted separate polls asking readers to dial a 900 number to vote for their favorite member of the phenomenally popular musical group, New Kids on the Block. See id. at 304. Both publications used the band’s name and charged for use of the 900 number. See id. Kozinski, writing for the three-member panel, upheld summary judgment for the defendants against plaintiffs’ trademark infringement and misappropriation claims, reasoning that “it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using the mark.” Id. at 306.

In reaching his decision, Kozinski flatly rejected plaintiffs’ argument that the fair use defense does not properly apply when the challenged use competes directly with a trademark holder’s use. See id. at 309. Kozinski replies:

We reject this argument. While the New Kids have a limited property right in their name, that right does not entitle them to control their fans’ use of their own money. Where, as here, the use does not imply sponsorship or endorsement, the fact that it is carried on for profit and in competition with the trademark holder’s business is beside the point. Voting for their favorite New Kid may be, as plaintiffs point out, a way for fans to articulate their loyalty to the group, and this may diminish the resources available for products and services they sponsor. But the trademark laws do not give the New Kids the right to channel their fans’ enthusiasm (and dollars) only into items licensed or authorized by them. The New Kids could not use the trademark laws to prevent the publication of an unauthorized group biography or to censor all parodies or satires which use their name. We fail to see a material difference between these examples and the use here. Id. (emphasis added) (citations and footnote omitted). Although this case implicated First Amendment concerns because of the nature of the publications, see id. at 305. Kozinski’s comments seem to suggest that he would prefer not to recognize any difference between traditional fair uses, such as satire and comparison, and blatant use of a celebrity’s persona for commercial promotion of merchandise. However, Kozinski does put three limitations on the fair use doctrine:

[(1)] the product or service in question must be one not readily identifiable without use of the trademark; [(2)] only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; [and (3)] the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

Id. at 308.

107. See Madow, supra note 10, at 194–95 (describing the phenomenon whereby gay males adopted the image of Judy Garland to express sexual identity); see also Coombe, supra note 17, at 382–83 (describing the process by which middle-class women “articulate new gender identities” by authoring Star Trek “fanzines”—new Star Trek stories exploring gender roles, sexuality, and professional opportunities for women in the future).

108. See Coombe, supra note 17, at 381–82, cited in Madow, supra note 10, at 143.


110. See id. at 145; see also Cardtoons v. Major League Baseball Players Ass’n, 95 F.3d 959, 974 (10th Cir. 1996).
that “if the purpose is ‘informative or cultural’ the use is immune.”

Moreover, the Sixth Circuit made it clear in Carson v. Here’s Johnny Portable Toilets, Inc. that conduct that infringes the right of publicity is the promotion of a product, rather than the production of a product.

Admittedly, the dividing line between infringement and protected use is not always clear-cut. However, a New Jersey district court explained it well in Presley’s Estate v. Russen. Analogizing to the fair use defense of copyright law, the Presley court reasoned that similar exceptions to the right of publicity should be recognized. Such exceptions arise when the imitation:

predominantly serves a social function valued by the protection of free speech. If the portrayal mainly serves the purpose of contributing information, which is not false or defamatory, to the public debate of political or social issues or of providing the free expression of creative talent which contributes to society’s cultural enrichment, then the portrayal generally will be immune from liability.

Without explicitly adopting it, the court discussed a two-step analysis to determine when such exceptions should apply. First, the court must determine whether the imitation is exploitative, then whether the plaintiff has suffered economic or dignitary harm. The point of the analysis is that “the scope of the right of publicity should be measured or balanced against societal interests in free expression.” When the copying is done primarily to promote the sale of consumer merchandise or “solely for purposes of trade,” as distinguished from dissemination of news or information, or contribution to culture, then the right of publicity should prevail.

111. Midler v. Ford Motor Co., 849 F.2d 460, 462 (9th Cir. 1988); see also White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1401 (9th Cir. 1992) (“Defendants’ parody arguments are better addressed to non-commercial parodies. The difference between a ‘parody’ and a ‘knock-off’ is the difference between fun and profit.”).

112. 698 F.2d 831 (6th Cir. 1983). The plaintiff in Carson, John W. Carson, was the long-time star and popular host of The Tonight Show. See id. at 832. From the time he began to host the show, Carson was always introduced by the signature phrase, “Here’s Johnny,” and the viewing public generally associated the phrase with Carson. See id. at 832–33. The defendant rented and sold “Here's Johnny” portable toilets and had named his business “Here’s Johnny Portable Toilets, Inc.” See id. at 833. He also sometimes coupled the “Here’s Johnny” toilet with the phrase “The World’s Foremost Comedian.” See id. Not amused, Carson sued under, inter alia, the right of publicity. See id. The Sixth Circuit found that the defendant had intentionally chosen the accused phrase to trade on Carson’s celebrity status and promote its products, and the Sixth Circuit upheld Carson’s cause of action under publicity rights. See id. at 836.

113. See id. at 835.


117. Id. at 1356 (internal citation omitted).

118. See id. at 1355.

119. See id. at 1356 n.13.

120. Id. at 1356.

121. Id. at 1358 (internal quotation marks and citations omitted) (emphasis added).
An examination of cases where a fair use defense prevailed over a right of publicity claim provides even further clarity. For example, Justice Bird’s farsighted opinion in *Guglielmi v. Spelling-Goldberg Products, Inc.*, 122 provides a sensible framework for analysis. In *Guglielmi*, the alleged nephew of Rudolph Valentino brought suit under the right of publicity when defendant televised a fictitious account of Valentino’s life and advertised the film using his name and likeness. 123 Justice Bird explained that “[f]ree speech encompasses the discussion of ‘all issues about which information is needed or appropriate to enable the members of society to cope with the exigencies of their period.’” 124 Moreover, “entertainment [including works of fiction] is entitled to the same constitutional protection as the exposition of ideas.” 125 Further, “the manner in which the ideas, thoughts and beliefs are expressed” is irrelevant; all media are protected equally. 126 Nor does a protected activity “lose its constitutional protection because it is undertaken for profit.” 127 Finally, where the use of a celebrity’s identity is not an actionable infringement, the use of his or her identity in promoting the product is similarly not actionable under the right of publicity. 128 Although the court dismissed plaintiff’s claim because Valentino was long dead and the right of publicity was not descendible under the California statute in force at the time, Justice Bird made it clear that it would have failed anyway under defendant’s fair use defense. 129

As insightful as Justice Bird’s exposition of the “news and entertainment” defense to the right of publicity is, her caveats to that defense are perhaps even more instructive as to where to draw properly the line between permissible and impermissible conduct under the right. First, she noted that, “[w]hile Valentino’s name was allegedly used to advertise this particular film, this is not a case in which a celebrity’s name is used to promote or endorse a collateral commercial product or is otherwise associated with a product or service in an advertisement.” 130 Later, she explained further by contrasting *Guglielmi* with *Lugosi v. Universal Pictures*, 131 which had “involved the use of Bela Lugosi’s likeness in connection with the sale of such commercial products ‘as plastic toy pencil sharpeners, soap products, target games, candy dispensers and bever-

123. See id. at 456.
124. Id. at 458. *But see* Eastwood v. Nat’l Enquirer, Inc., 149 Cal. App. 3d 409, 424–25 (Ct. App. 1983) (holding that the “news” defense to the right of publicity does not apply when the publication was knowingly defamatory).
126. *Guglielmi*, 603 P.2d at 458 (emphasis in original); *see also* Cardtoons, 95 F.3d at 969.
127. *Guglielmi*, 603 P.2d at 459; *see also* Cardtoons, 95 F.3d at 970.
128. See *Guglielmi*, 603 P.2d at 462.
129. See id.
130. Id. at 457 n.6 (Bird, C.J., concurring) (emphasis added).
131. Id. (Bird, C.J., dissenting).
Justice Bird emphasized that “[t]hese objects, unlike motion pictures, are not vehicles through which ideas and opinions are regularly disseminated.”

Cardtoons v. Major League Baseball Players Ass’n provides a good example of where the fine line ought to be drawn between infringement under the right of publicity and the fair use of parody. Plaintiff Cardtoons filed for a declaratory injunction seeking a judgment that its parody trading cards did not infringe the publicity rights of the Association’s members. “The cards use[d] similar names, recognizable caricatures, distinctive team colors, and commentary about individual players” to ridicule and criticize them. In finding that defendant’s conduct was privileged, the court noted that, “Cardtoons added a significant creative component of its own to the celebrity identity and created an entirely new product . . . they do not merely advertise another unrelated product.”

Contrast Cardtoons with the recently decided case, Hoffman v. Capital Cities/ABC, Inc. In Hoffman, actor Dustin Hoffman successfully sued Los Angeles Magazine under the right of publicity when it used his name and digitally altered photograph in its Grand Illusions photo article without permission. The magazine described the article as a “fashion show” featuring famous celebrity models. None of the celebrities (many of whom were deceased) had actually posed for the magazine, however. Instead, the magazine obtained the celebrities’ images from movie stills and merged their heads and faces onto the bodies of clothing models so that the celebrities appeared to be modeling fashions designed by designers who were major advertisers of the magazine. The picture of Hoffman that the magazine used was a still from the movie Tootsie. The magazine merged Hoffman’s head and face, in full Tootsie make-up, with the body of a male model wearing an evening gown and heels. The accompanying text read: “Dustin Hoffman isn’t a drag in a butter-colored silk gown by Richard Tyler and Ralph Lauren heels.” The article also included a “shopping guide” that provided price and store information for the apparel.

132. Id. at 463 (citation omitted).
133. Id.
134. 95 F.3d 959 (10th Cir. 1996).
135. See id. at 962.
136. Id.
137. Id. at 970, 976 (emphasis added).
139. See id. at 873.
140. See id. at 871.
141. See id. at 870, 872.
142. See id. at 870.
143. See id.
144. See id.
145. Id.
146. See id.
The court properly rejected the magazine’s fair use defenses and awarded Hoffman compensatory and punitive damages. In justifying its decision, the court explained that the magazine’s use of Hoffman’s image “for its own advantage to sell magazines, advertise and promote designer clothing... crossed over the line between editorial content and advertising.” More importantly, the court provided, by negative implication, a description of what would have constituted a fair use in this case:

The Los Angeles Magazine article provided no commentary on fashion trends and no coordinated or unified view of current fashions. The article contains no statement that any particular style of clothes is in vogue, that any particular color is becoming popular, or that any type of fabric is attracting the attention of designers.... The article does not even constitute “news” about Mr. Hoffman’s clothing preferences because Mr. Hoffman never wore those designer clothes.

Had the magazine included legitimate news or commentary about Hoffman or fashion, the court likely would have found its use of his identity privileged. Thus, the litmus test for determining the viability of a celebrity’s right of publicity claim is the “newsworthiness” versus the commercial value of the offending product.

There are, however, two very troubling aspects of the Hoffman court’s decision. First and foremost, it found, as a matter of law, that one reason the magazine violated plaintiff’s right of publicity was that it had “used Mr. Hoffman’s name and likeness on or in products, merchandise or goods, namely, Los Angeles Magazine.” This language could give the erroneous impression that use of a celebrity’s identity in a magazine article would give rise to a cause of action under the right of publicity be-

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147. See id. at 873–76.
148. Id. at 873 (emphasis added).
149. Id. at 874–75.
150. See id.
151. See Stern v. Delph Internet Serv. Corp., 626 N.Y.S.2d 694, 698–99 (N.Y. Sup. Ct. 1995); see also Madow, supra note 10, at 130–31. Madow illustrates this concept by discussing right of publicity cases in which celebrities have prevailed and contrasting them with right to privacy cases lost by the same celebrity. See id. For example, diva Bette Midler prevailed against Ford Motor Company when it used an unauthorized sound-alike of her voice in a television commercial. See Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988). Yet, Midler would have no cause of action against a tabloid who published stories of her weight control battle without permission and without paying royalties. See Madow, supra note 10, at 131. Such cases are also distinguished in the RESTATEMENT OF UNFAIR COMPETITION § 47 (1995).
cause the magazine is, after all, a product. However, a thorough reading of the opinion makes it clear that, had the magazine used Hoffman’s likeness, or the *Tootsie* character, in an article for entertainment or news purposes rather than to promote a product, such use would have been an absolute defense to the right of publicity.153

The other point of concern is that the court found, again as a matter of law, that one reason the magazine’s fair use defenses failed was that “the use of Mr. Hoffman’s name and likeness was wholly unnecessary to deliver whatever message [the magazine] claims the . . . article contained.”154 The language seems to suggest that use of a celebrity’s identity must somehow be “necessary” to qualify for the fair use exemption. Again, however, First Amendment fair use must be an absolute defense to the right of publicity in order to preserve the balance between plaintiffs’ interests in protecting their identities and society’s interest in preserving a robust public domain.

Finally, Judge Kozinski asserts that the Ninth Circuit’s broad application of the right of publicity jeopardizes the artistic freedom of producers and screenwriters who want to re-create a character without using the original actor.155 Kozinski states:

To avoid going to trial in such a situation, producers will have to cast new actors who look and sound very different from the old ones. A Seinfeld spin-off thus ends up in a bizarro world where a skinny Newman sits down to coffee with a svelte George, a stocky Kramer, a fat Jerry and a lanky blonde Elaine. Not only is goodwill associated with the old show lost, the artistic freedom of the screenwriters and producers is severely cramped.156

Kozinski’s fear can be answered quite simply by reference to the “entertainment” fair use defense already described by Justice Bird in *Guglielmi*.157 That case, however, involved a celebrity biography. *Nurmi v. Peterson*158 is a closer case to the re-casting problem presented by Kozinski. *Nurmi* involved a right of publicity claim by 1950’s horror movie hostess, “Vampira,” against the creators of the 1980’s character “Elvira.”159 Elvira bore an “approximate resemblance” to Vampira,

153. *See id.* at 874–75.
154. *Id.*
155. *See Wendt v. Host Int’l, Inc.*, 197 F.3d 1284, 1286–87 (9th Cir. 1999) (Kozinski, J., dissenting) (*Wendt II*) (“Can Paramount cast Shelley Long in The Brady Bunch Movie without creating a triable issue of as to whether it is treading on Florence Henderson’s right of publicity?”).

Kozinski echoed sentiments expressed earlier by Judge Alarcon in his dissent to *White I*. Judge Alarcon feared that the *White I* decision might mean that Vanna White could bring a cause of action when “another blonde performer or robot appears on [the] set as a hostess” of another television game show. *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1405 (9th Cir. 1992) (Alarcon, J., dissenting) (*White I*).

156. *Wendt II*, 197 F.3d at 1287 n.6.
157. *See id.*
159. *See id.* at 1777.
dressed similarly in black, and used similar horror movie props. Finding that “likeness” as used in the California right of publicity statute did not include general resemblance, the court dismissed the complaint. It was heavily influenced to do so, however, by its concern that:

Such a definition would expand § 3344 to freeze all rights to certain props, clothing, or other qualities surrounding a character with the first person to portray a given part. In effect, all subsequent actors would be subject to legal challenge on the grounds that they had copied elements of characters portrayed by earlier generations of actors. This result would greatly inhibit the development of the entertainment arts and the freedom of expression, a result the Court finds cannot have been intended by the California legislature in drafting § 3344.

Because Nurmi was decided under California statutory law, it can be distinguished from case like White I and Wendt I where the Ninth Circuit used California common law to expand the right of publicity. Thus, one can distinguish Nurmi from those cases on that basis. However, Nurmi does stand for the basic proposition that use of general characteristics to re-create a character falls under the entertainment exception to the right of publicity.

A good illustration of this principle is MGM Studios’ “James Bond” character portrayed by, in order of appearance, Sean Connery, George Lazenby, Roger Moore, Timothy Dalton, and Pierce Brosnan. Although all the actors attempted to play Bond with the same mix of charisma, suave sophistication, and physical prowess that defined the character, each actor’s performance was unique, and MGM did not try to cast a double of any of them in the role. Therefore, none of the actors could have sustained a publicity claim.

The preceding discussion demonstrates that celebrities have certain social interests in controlling their identities that the law recognizes through the right of publicity. However, these individual interests must yield to the greater public interest in free expression when the use of the identity is a privileged fair use. The next section will examine the economic policies surrounding publicity rights.

B. Economic Debate over the Right of Publicity

The Supreme Court, in Zacchini v. Scripps-Howard Broadcasting Co., a case where a television newstation showed Zacchini’s entire human cannonball act without permission, expressly recognized a policy in-

160. See id.
161. See id. at 1778–79. For a description of the California right of publicity statute, see supra note 20.
162. Id. at 1777–78.
163. MGM Studios, Inc. owns intellectual property rights in the “James Bond” character.
interest in providing an economic incentive to performers to “make the investment required to produce a performance of interest to the public,” similar to the incentives afforded inventors and authors under patent and copyright laws. However, critics argue that celebrities are already well compensated for the activities that develop their personas. There is, therefore, no need to provide the additional incentive of a right of publicity, because such right protects only a “collateral” source of income for the celebrity. In fact, the argument has been extended further to propose that the right of publicity can actually function as a disincentive to creativity because the actor who has developed a well-defined public persona might be inclined to forego contrary types of roles that might jeopardize that profitable image.

There are fatal flaws in the entire theory, however. First, while it may be true that the actor was compensated for his performance of the fictional character, “creation of a unique and marketable image [is] a separate byproduct for which [an actor is] not compensated.” Second, the law has never withheld a legitimate property right from the owner of that right because he already possesses an abundance of the benefits which accrue from that right. For example, the law does not, as a general rule, limit the amount of real property one may own. Likewise, no legal basis exists for the argument that the property rights celebrities own in their identities should not be enforced because a celebrity has no need of the financial benefits of those rights. Finally, there is no legal, or social, basis for any argument that incentive should be removed for a celebrity to accept only those types of “safe” roles for which he has become famous. Just as the law cannot force a businessman to invest in high-risk stocks, it cannot be used as leverage against a celebrity to persuade him to undertake diverse roles that might prove unpopular with the public.

Finally, it is unclear why we should view role diversity as socially desirable. Some of the most beloved stars have achieved fame by consistently portraying characters with similar attributes. To return to Madow’s example, John Wayne was famous for his portrayals of rugged, macho men. As a result, he became an American icon for that semiotic


166. E.g., Cardtoons, 95 F.3d at 973; Madow, supra note 10, at 136–37.

167. See Cardtoons, 95 F.3d at 973–74 (calling Zacchini a “red herring”); Madow, supra note 10, at 209.

168. See Madow, supra note 10, at 212; see also Kwall, supra note 15, at 56 n.19 (quoting actress Bette Davis “I firmly believe that the public must know 75 percent of what to expect from an actor.”).

169. Marks, supra note 80, at 812; see also Hughes, supra note 83, at 171 (“[T]he ‘Dracula’ character—particularly Lugosi’s rendition of it—was a valuable property separate from any films in which it appeared.”).

170. See Madow, supra note 10, at 199 (explaining that Sanka chose actor Robert Young as its spokesperson because he represented ‘deliberate, mature, seasoned advice,’ a persona that was “largely the product of the roles Young had previously played on television”).

171. See Madow, supra note 10, at 144–45.
image, and American culture was the richer for it. If celebrities are not encouraged to cultivate identifiable images, how will they provide fodder for new semiotic images for generations to come? On this point, it seems that Madow contradicts himself.

A second economic justification for publicity rights is the law and economics theory that granting exclusive control over the commercial use of the celebrity identity to the celebrity promotes the efficient allocation of resources. Without the artificial scarcity created by publicity rights, identities would be commercially exploited until the marginal value of each is zero. This is the “familiar tragedy of the commons” paradigm. Publicity rights preserve the value of identity to the celebrity, to the advertiser, and to the consumer, “who receive[s] information from the knowledge that [the celebrity] is being paid to endorse the product.” As a consequence, publicity rights also serve to protect consumers from deception by prohibiting advertisers from using a celebrity’s identity without authorization to imply that the celebrity endorses the product. But this begs the question, if celebrity identity is a collaborative effort, why invest the celebrity with exclusive control rather than one of the other major collaborators—say the producer? The answer is that the identity is most valuable to the celebrity; therefore, she is the entity most likely to conserve the value of that identity by appropriately policing its use. Also, handing over control of identity to someone other than its source seems inherently wrong.

The final economic justification for the right of publicity is the prohibition against unjust enrichment. This is the familiar INS v. Associated Press admonition to the free-rider that it should not “reap where it has not sown,” and it is a staple ingredient of most court opinions upholding the right of publicity. One district court went so far as to describe the conduct of the advertiser who used Bette Midler’s voice without permission as that of the average thief. While “thief” may be too harsh a label, particularly where the advertiser holds a license from the imitated work’s copyright owner, it does express the commonly held sentiment that one should not profit from another’s efforts without invitation. Regardless of who else participates in fabricating the celebrity

172. See Cardtoons, 95 F.3d at 974.
173. Id. (quoting Matthews v. Wozencraft, 15 F.3d 432, 437–38 (5th Cir. 1994), but rejecting the argument on the ground that the Lanham Act already provides sufficient protection).
174. See id.
175. See id.
176. See Matthews, 15 F.3d at 438.
177. In fact, the major film studios did control the careers and public personas of movie stars in the early days of the industry. The eventual disenfranchisement of that industry resulted in greater creative freedom for the stars. See Kwall, supra note 15, at 30.
178. See Coombe, supra note 17, at 368; Marks, supra note 80, at 789 n.13.
identity, the advertiser rarely does. Rather, the advertiser capitalizes on the after-the-fact value of that identity.182

Madow first argues that prevention of unjust enrichment is not a compelling justification for the right of publicity because celebrities themselves draw on the efforts of others—a type of “unclean hands”183 argument. He writes:

When a quintessentially “postmodern” (that is, openly and unabashedly derivative) performer like Madonna complains of unauthorized appropriation of her image, she is seeking to have it both ways. Having drawn freely and shamelessly on our culture’s image bank, she is trying to halt the free circulation of signs and meanings at just the point that suits her. She is seeking to enforce against others a moral norm that her own self-consciously appropriationist practice openly repudiates. The law need not be a party to such contradiction.184

However, Madow fails to recognize that the law has long acknowledged that creativity rarely comes in a “flash of genius,”185 but rather draws heavily upon the work of others.186 This premise underlies the compromise in the patent system that gives the inventor a limited monopoly on his invention in exchange for publication of the invention so that others may improve upon it.187 The copyright law also implicitly acknowledges this premise in its minimal standard for copyrightability: “[T]he requisite level of creativity is extremely low; even a slight amount will suffice . . . no matter how crude, humble or obvious it might be.”188

Next, Madow argues that no established general law of misappropriation exists, and that the existing law encourages free-riding in the form of imitation to promote creativity.189 Although not an inaccurate statement of the law,190 Madow misapplies the law, as evidenced by the examples he uses to illustrate his point—rubber tires, ice cream cones, automobiles.191 These are all examples of products. The law generally treats very favorably conduct, even imitative conduct, which results in provision of a new product or service to the public because these new

182. See White I, 971 F.2d at 1399.
183. See Madow, supra note 10, at 196–98.
186. See White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting) (White II) (“Nothing today, likely nothing since we tamed fire, is genuinely new. Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before.”).
187. See ADELMAN ET AL., supra note 185, at 34 (“[T]he patent system promotes disclosure of new inventions and thereby enlarges the public storehouse of knowledge.”).
189. See Madow, supra note 10, at 201–02.
191. See generally Madow, supra note 10 (illustrating his point through the use of such examples as rubber tires, ice cream cones, and automobiles).
products and services are often better or cheaper than the old. However, the law takes a harder look at imitative conduct that does not produce a tangible product or service. The Court of Appeals for the Third Circuit alluded to this premise in *United States Golf Ass’n v. St. Andrews Systems*, a general misappropriation case. There, the court recognized an exception to the direct competition element of the tort of misappropriation in those instances where defendant unfairly trades on the goodwill of the plaintiff. The court explained that imitative conduct is prohibited in situations where “the information involved is so closely associated with the creator and has so little intrinsic value that the use of the information by the competitors is really an attempt to trade on the ‘good will’ of the creator, and thus should be prohibited.” Advertising is conduct designed to promote a product, not produce one. In such situations, the use of the celebrity’s goodwill is not balanced by a tangible benefit to the public. (The public does not even receive the aforementioned benefit of obtaining the information that the celebrity endorses the product because, of course, he does not.) Therefore, misappropriation of a celebrity’s identity in order to promote a product by trading on that celebrity’s goodwill should be prohibited conduct. There are any number of ways to disseminate information to the public about a new product without using a celebrity identity. That it may be easier, or more profitable, to do so does not justify the conduct.

Madow’s last argument against the unjust enrichment rationale for publicity rights is that the celebrity suffers no unfair loss because the advertiser is not in direct competition with the celebrity. An advertisement is short-lived and does not compete with the works of the celebrity—it does not saturate her audience or curtail her market. As explained above, direct competition is not required for misappropriation when the thing unfairly taken is the owner’s goodwill. The exception was confirmed in the *Midler* right of publicity case. The court noted that “defendants were not in competition with her . . . . Midler did not do television commercials.” Nevertheless, the court upheld her right of publicity claim.

The previous discussion demonstrates that economic policies such as providing an incentive to entertain or inform, efficient allocation of resources, and prevention of unjust enrichment justify investing celebri-

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193. 749 F.2d 1028 (3d Cir. 1984).
194. *See id.* at 1039.
195. *Id.*
196. *See Madow, supra* note 10, at 128 (“[S]tar images enhance the cultural value of commodities with which they are associated.”).
199. *See id.*
200. *Id.*
201. *See id.* at 463.
ties with exclusive control of the commercial exploitation of their identities. The next section will discuss whether such exclusive control conflicts with the rights of copyright owners, particularly when the celebrity wishes to prevent a copyright owner from exploiting a fictional character that is an element of the copyrighted work.

C. Potential Conflict Between Copyright Law and the Right of Publicity

Warren and Brandeis described the right of privacy, from which the right of publicity evolved, as a separate right “entirely independent of the copyright laws.”202 However, independence does not automatically exempt the right from preemption by federal copyright law, which, under § 301, preempts all rights created by state law that are equivalent to those rights within the scope of the Federal Copyright Act.203 Tension between the two doctrines often arises because advertisers frequently use a fictional character with which the actor is closely associated to evoke her identity, and that character is most likely an element of a copyrighted work.204 Conflict arises when, as in Wendt I, the copyright owner, or its licensee, uses the copyrighted character to promote a product, but that use evokes the actor’s identity and triggers publicity rights.205

Defendant in Wendt I argued that federal copyright law preempted plaintiffs’ claims because the Cheers setting evoked the “Norm” and “Cliff” characters, not the plaintiffs’ identities as individuals.206 However, the court held that plaintiffs’ right of publicity claims were not preempted because they “contain[ed] elements that are different in kind from copyright infringement.”207 The distinct element the court identified was the invasion of personal rights.208 Other courts have relied upon the “appropriation of the plaintiffs’ names and likenesses for advertisement purposes to supply the additional element, unrelated to copyright infringement, necessary to avoid preemption.”209

203. See 17 U.S.C. § 301 (1994). Federal copyright law preempts all state laws that conflict with: all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103.

Id.

205. See Wendt v. Host Int’l, Inc., 125 F.3d 806, 809 (9th Cir. 1997) (Wendt I).
206. See id. at 811.
207. Id. at 810.
208. See id.; see also Hoffman v. Capital Cities/ABC, Inc., 33 F. Supp. 2d 867, 871 (C.D. Cal. 1999) (holding that the right “to protect the use of [one’s] own name and image is separate from the copyrighted interest of [the copyright owner in the copyrighted work]”).
Some courts, however, have refused to recognize an actor’s claim of rights in a fictional character on the theory that to do so would unduly restrain the advertising market for the underlying copyrighted work because a prospective licensee would need to obtain permission from each of the potentially numerous performers who might have rights in the work before the licensee could safely use it.210 The theory, however, is based on the misunderstanding that an entertainer’s refusal to grant permission for imitation or use of his or her distinctive personality attribute(s) embedded in a copyrighted work would prevent an advertiser from using that work.211 Because the actor does not own rights to the copyright of the underlying work, the advertiser would still be free to use that work, so long as he substituted other, nonimitative attributes for those of the actor.212 For example, if defendants had changed the body styles of the robots in Wendt I instead of changing their names from “Norm” and “Cliff” to “Hank” and “Bob,” they likely would have avoided liability.213 Thus, marketability of the underlying copyrighted work can be maintained while fairly compensating the entertainer for use of his or her persona “for purposes of trade.”214

A celebrity’s right of publicity should not interfere with a copyright owner’s legitimate use of the copyrighted work, however. For example, a copyright owner, or its licensee, should not be restrained by fear of publicity claims from using the copyrighted work containing an actor’s performance, or portions thereof, or other audiovisual performance, solely for entertainment purposes in a motion picture or television show. On this premise, a California court upheld copyright licensee CBS’s right to distribute and exhibit the film White Dragon in Fleet v. CBS, Inc.,215 despite plaintiffs’ claim that such distribution violated their rights of publicity because they had not been compensated for their performances therein.216 The Fleet court held that an actor cannot sustain a cause of action for misappropriation of identity under the right of publicity “when the only alleged exploitation occurred through the distribution of the actor’s performance in a motion picture.”217

210. See Booth v. Colgate-Palmolive Co., 362 F. Supp. 343 (S.D.N.Y. 1973) (refusing to recognize actress’ claim when defendant, with permission from the owner of the underlying copyrighted cartoon to use the character, did not obtain the actress’ permission to imitate her voice in its commercial).


212. See id.

213. See Wendt v. Host Int’l, Inc., 197 F.3d 1284, 1285 n.5 (9th Cir. 1999) (Kozinski, J., dissenting) (Wendt II) (“In a half-hearted attempt to avoid litigation, Host changed the robots’ names to ‘Hank’ and ‘Bob.’”).

214. See Shipley, supra note 211, at 419.


216. See id. at 1913, 1915.

217. Id. at 1913. It is important to note that the court explicitly did not base its decision on any consideration of copyright’s “work-for-hire doctrine.” See id. at 1917 (“[W]e do not decide whether an actor who performs in a motion picture is an employee of the producer or an independent contractor
Following suit, Judge O'Scannlain of the Ninth Circuit upheld the dismissal, in *Comedy III Products, Inc. v. New Line Cinema*,218 of plaintiff Comedy III's complaint alleging misappropriation of the *Three Stooges*’ names, characters, and likenesses by the unauthorized use of a clip of the trio in one of New Line's motion pictures.219 After considering, and rejecting as inapplicable, the Ninth Circuit's cases addressing the right of publicity,220 the *Comedy III* court ruled that, since the copyright on the film clip had long expired, it had entered the public domain, and any right of protection from misappropriation of the clip itself was preempted by the Copyright Act.221 However, the court clarified its holding by noting that the outcome might have been different if New Line had been selling T-shirts embossed with the *Three Stooges*’ likenesses.222

This “entertainment” exception would also extend to instances where the copyright owner or licensee reused the actor's performance, or portion thereof, in a new film or television show for entertainment purposes. For example, a California court held that James Brown could not prevent Twentieth Century Fox from using a clip of his 1965 television performance of the song “Please, Please, Please” in a 1991 motion picture about a fictional rock and roll band, *The Commitments*, when Fox had lawfully obtained the copyright.223

Considering the effort required to differentiate between copyright and the right of publicity, one might well wonder if it would not be sufficient to amend the Copyright Act to include a fictional character category. The simplest answer to that question is that copyright law cannot protect a celebrity’s entire identity because the courts have determined that “a human likeness is not copyrightable.”224 Therefore, adding a fictional character category to copyright law would only serve to subdivide

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218. 200 F.3d 593 (9th Cir. 2000).
219. See id. at 594–95. Comedy III purported to own all rights and interests in the *Three Stooges*. See id. at 594.
220. The cases the court considered were *Wendt v. Host International, Inc.*, 125 F.3d 806 (9th Cir. 1997) (*Wendt I*); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); and *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) (*White I*). See *Comedy III*, 200 F.3d at 595–96. The *Comedy III* court distinguished each of these cited cases on the basis that, in each, an imitation of the artists' performances was used rather than footage of their actual performances. Additionally, the imitations were used to advertise a product rather than to entertain. See id. at 596.
221. See id. at 595.
222. See id. at 596.
224. *KNB Enters.*, 92 Cal. Rptr. 2d at 715.
those indicia of identity currently protected under the right of publicity and further confuse that body of law. As the next section discusses, however, the doctrine sorely needs some federal scheme of harmonization and uniform application.

IV. APPLICATION OF THE RIGHT OF PUBLICITY

A. The Need for Federal Protection

Commentators are calling for national protection of those rights currently only protected under state statutory and common-law rights of publicity. The law has not developed in an orderly fashion and exists as only a “patchwork quilt” of those various state laws. Critics of the current system, or lack thereof, contend that inconsistency in the law and the resulting uncertainty in its application are rampant and have called for a federal statute to remedy the situation. Proposals include enacting a federal right of publicity, or amending either the Copyright Act or Trademark Act to include a right of publicity category. Supporters of extending the right of publicity to fictional characters, including the author, advocate providing for such a right in a federal statute.

Benefits of federal protection would be significant. First, a federal law would harmonize and bring uniformity to the widely varied state right of publicity laws, resulting in a predictability on which both publicity rights owners and those wishing to safely take from the public domain could rely in ordering their conduct. Under the current state of the law, celebrities’ rights are protected only to the extent of those state laws affording the least protection. Conversely, those wishing to lawfully take from the public domain to create works that will be used nationally must comply not only with the laws of their own jurisdiction, but also with the most restrictive laws of other states. Second, a national right


226. See Martin, supra note 225, at 133 (commenting that “the right of publicity is a patchwork quilt of various state laws”).


228. E.g., Feldman, supra note 101, at 688.


230. See generally Angela D. Cook, Note, Should Right of Publicity Protection Be Extended to Actors in the Characters Which They Portray, 9 DEPAUL-LCA J. ART & ENT. L. 309 (1999).

231. See Martin, supra note 225, at 133–34. State laws diverge on whether to recognize the right at all, whether the right is descendible, what range of attributes to protect, and the term of protection. See id. at 133.

232. See Goodman, supra note 225, at 227–28; Martin, supra note 225, at 134.

233. See Goodman, supra note 225, at 227–28; Martin, supra note 225, at 134.
would be efficient for both the celebrities who own publicity rights and those who wish to use their identities. Celebrities would be able to more easily identify and pursue infringers under a uniform national right, and both celebrities and prospective licensees would benefit from the decreased transaction costs of negotiating a license.\textsuperscript{234} Finally, a national right would eliminate forum shopping.\textsuperscript{235} As the next section will demonstrate, any federal right of publicity statute should provide for protection against unauthorized use of a fictional character that evokes a celebrity’s identity and is not excused by fair use.

B. Right of Publicity as Applied to Fictional Characters

Since celebrity identity is such a popular and valuable commodity in American culture, the advertiser “has a built-in financial incentive to make the plaintiff celebrity’s identity as distinctive and noticeable as possible.”\textsuperscript{236} Thus, advertisers often design an advertising campaign to capitalize on the association between the actor and a character that he has portrayed in such a way that “the celebrity and the role are shrewdly merged for the purpose of making a sale.”\textsuperscript{237} The courts have perceived the advertisers’ intentions, however, and have refused to permit the unauthorized use of celebrity identities for such purposes.\textsuperscript{238}

Justice Bird, in her \textit{Lugosi} dissent, opined that celebrities should have publicity rights in fictional characters because it is they who create public recognition by portraying particular characters such as Charlie Chaplin’s “Little Tramp,” Carroll O’Connor’s “Archie Bunker,” and Flip Wilson’s “Judge” and “Geraldine.”\textsuperscript{239} Justice Bird explained:

The professional and economic interests in controlling the commercial exploitation of their likenesses while portraying these characters are identical to their interests in controlling the use of their own “natural” likenesses. Indeed, to the extent one’s professional endeavors have focused on the development of one or more particular character images, protection for one’s likeness in the portrayal of those characters may well be considerably more important than protection for the individual’s “natural” appearance. Hence, there appears no reason why the right of publicity should not extend to one’s own likeness while portraying a particular fictional character.\textsuperscript{240}

Justice Mosk expressed the opposing view in his \textit{Lugosi} concurrence. He believed that “[m]erely playing a role . . . creates no inherit-

\begin{itemize}
\item \textsuperscript{234} See \textit{Martin}, supra note 225, at 134.
\item \textsuperscript{235} See \textit{id}.
\item \textsuperscript{236} Keller & Bernstein, \textit{supra} note 19, at 82.
\item \textsuperscript{237} Rosenberg, \textit{supra} note 6.
\item \textsuperscript{238} \textit{E.g.}, \textit{White} v. \textit{Samsung Elecs. Am.}, Inc., 971 F.2d 1395, 1399 (9th Cir. 1992) (\textit{White I}) (noting to what great lengths defendants had gone to associate the robot with Vanna White).
\item \textsuperscript{239} See \textit{Lugosi} v. \textit{Universal Pictures}, 603 P.2d 425, 444 (Cal. 1979).
\item \textsuperscript{240} \textit{Id}.
\end{itemize}
able property right in an actor.” Judge Alarcon, in his dissent to White, joined Justice Mosk in expressing a belief that the identifying characteristics of the performer must be distinguished from those that are merely “attributes of the role she plays.”

In Wendt I, the Ninth Circuit did distinguish between the characteristics of fictional characters and the likeness of the actors who portrays them and nevertheless held that “[w]hile it is true that appellants’ fame arose in large part through their participation in Cheers, an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character.” The court correctly decided the issue because, as even Judge Kozinski admitted, “[o]utside name, likeness and voice, the things that most reliably remind the public of celebrities are the actions or roles they’re famous for.

Professor McCarthy, a prominent scholar in the field of trademark and unfair competition law, and the Third Circuit have explicitly acknowledged that a celebrity’s persona can be so closely associated with a fictional character that use of that character necessarily invokes the celebrity’s identity and should, therefore, be governed by the right of publicity. The Ninth Circuit has implicitly recognized the same in its White I and Wendt I decisions. The next section suggests a general analysis, gleaned from the case law, for determining infringement of celebrity identity via inappropriate use of a fictional character.

C. Proposal for Protecting the Right of Publicity in Fictional Characters

From the above discussion of the problems inherent in the current state law scheme and the benefits to be gained from enacting a federal statute, it is clear that one is needed. Because the courts have recognized that appropriation of a fictional character can violate a celebrity’s right of publicity by evoking his identity, any federal statute should include a provision for protection of fictional characters. Student author Angela Cook recently suggested that the McFarland “association” test provides the basis for a federal right of publicity statute that would protect celebrities from unauthorized use of a fictional character they had portrayed if such use evoked the celebrity’s identity. However, Cook would apply the test on a sliding scale so that no showing of association would be re-

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241. Id. at 432 (Mosk, J., concurring).
242. White I, 971 F.2d at 1404 (Alarcon, J., dissenting).
243. Id.
244. White v. Samsung Elecs. Am., Inc., 989 F.2d 1512, 1515 n.18 (9th Cir. 1993) (Kozinski, J., dissenting) (White II).
245. Professor McCarthy’s treatise is the standard authority in the field. See J. Thomas McCarthy, McCarthy on Trademark and Unfair Competition (4th ed. 1998).
246. See McFarland v. Miller, 14 F.3d 912, 920 (3d Cir. 1993); J. Thomas McCarthy, Rights of Publicity and Privacy, § 4.13[A], at 4-72.3 (1987) (“[A] person can be identifiable for Right of Publicity purposes by the taking of a persona in a role or characterization.”).
247. See Cook, supra note 230, at 312; see also Kwall, supra note 15, at 44.
required for those celebrities, like talk show or game show hosts, who are “implicitly associated” with their characters because they project their own personality into them. On the other end of Cook’s scale, “an actor who portrays a character unique from the actor personally must establish that he or she has imparted some level of creativity or originality in the character in order to elicit public recognition of the actor upon exploitation of the character.”

While the McFarland test is an appropriate basis for a federal right of publicity statute, it must be applied uniformly. First, any celebrity should be required to show as an element of her prima facie case under the right of publicity that the public so closely associates her with the appropriated character that defendant’s use evokes her identity. Inclusion of the unauthorized use of a celebrity’s character, while justified, already stretches the meaning of “appropriation of identity” to its limits. Permitting a right of publicity claim for unauthorized use of a character, without a showing of association between the character and the celebrity, stretches it too far. Without the requisite association in the public’s mind between the celebrity and the character, use of the character cannot appropriate the celebrity’s identity because it does not even evoke the celebrity’s identity.

Conversely, Cook’s creativity requirement would inappropriately narrow publicity rights. Such a requirement is unnecessary because creativity or originality is an implicit component of the association test. Further, a creativity or originality requirement is inappropriate for the right of publicity because, unlike copyright, the owner obtains no positive rights. Instead, the celebrity obtains only the negative right to prevent others from misappropriating his persona. Thus, the higher burden is unwarranted. Another problem with the requirement is how to measure creativity. Often it is an actor’s goal to portray the quintessential stereotype of whatever character he has been assigned. Would such a performance qualify as “creative”? To put it differently, if Clint Eastwood drew upon the public’s every preconception about cowboys and incorporated them into the cowboy roles he played, would any of those performances satisfy a creativity requirement? At any rate, the point is moot because common sense dictates that there must have been something memorable or creative about a celebrity’s performance in the first instance to cause the public to intimately associate him with the character. To impose the additional burden of meeting such an uncertain standard as “creativity” is unnecessary and should be reserved for those instances when the actor claims a copyright in the character.

248. See Cook, supra note 230, at 347.
249. Id.
The Ninth Circuit’s “appropriation of identity” test extracted from its *White I* and *Wendt I* decisions should define the scope of the right. “Identity” should include such indicia as name, likeness, voice, signature, nickname, gestures, mannerisms, identifying phrases (exclusively associated with the plaintiff celebrity), and fictional characters. Where the appropriated identity is a fictional character, the celebrity plaintiff must satisfy the following two-prong test.

First, plaintiff must show that defendant has taken her persona by using a fictional character that identifies her in the public mind—also a two-step process. Plaintiff must first prove that the character the defendant used is that which plaintiff claims. In meeting its burden, plaintiff may use evidence such as wardrobe, physical features (hair color and style, body type, voice, race, etc.), gestures (including poses), mannerisms, and external background (props, setting, locale, presence of associated characters) to show that defendant’s character and plaintiff’s character are one and the same. Next, plaintiff must demonstrate that she is so closely associated with the character that its use evokes her identity in the public’s mind. In meeting this burden, plaintiff may rely on evidence such as extensive media coverage, success of the work in which the character appeared (box office sales, television ratings, etc.), successful character merchandising, or other indicia of widespread notoriety, as well as individual testimony and survey evidence (of a relevant audience).

Second, plaintiff must show that defendant used the character in advertising to promote a product that is not exempted by the fair use doctrine. As shown by the cases, prohibited conduct does not include fair use of celebrity identity for news, commentary, or entertainment (including parody and satire) purposes, or the advertisement of products that result from fair use. If plaintiff fails to meet its burden, defendant’s use is privileged. The two hypotheticals posed in the introduction further illustrate the distinction between prohibited commercial use and privileged fair use. In the “Uhura” example, Nichols would clearly have a cause of action because the “Uhura” character was used solely to promote a product. In the “Kirk” and “Spock” example, however, Shatner and Nimoy would have no cause of action against *Saturday Night Live* because, when used solely to entertain, parody is a complete defense to the right of publicity.

251. Judge Kozinski would strenuously disagree with this dichotomy. He correctly believes that, “[c]ommercial speech is a significant, valuable part of our national discourse.” *See* *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1520 (9th Cir. 1993) (Kozinski, J., dissenting) (*White II*). He asks, “Is the Samsung parody any different from a parody on *Saturday Night Live* or in *Spy Magazine*?” *Id.*

The answer is that it is very different. The Samsung “parody” was clearly intended to promote a product, not to entertain. Even conceding Kozinski’s point that advertisements contain some entertainment value that contributes to our national culture, that (minimal) benefit must be weighed against the harm to the celebrity whose identity has been appropriated. The courts have correctly decided that, where the purpose is to commercially advertise a product, the harm to the celebrity outweighs any minimal social benefit.
The above test does immediately raise a few questions, however. For example, should it make a difference in determining whether the celebrity is identified with the accused character that the actor is also associated with other characters? For example, after *Star Trek*, William Shatner portrayed police officer “T.J. Hooker” in a television series of the same name. What result, then, if an advertiser were to use Shatner’s identity, via the “Kirk” character? The answer should not depend on whether Shatner played other characters with which he became identified. If the use of any character he portrayed invokes his persona, then such use should satisfy the “appropriation of identity” prong of the infringement analysis under the right of publicity.

A similar question arises when more than one actor has portrayed the accused character. For example, this situation could arise if an advertiser were to use the “James Bond” character to promote a product. Would any of the actors who portrayed Bond have a claim? Would all the actors have a claim? This is a fact intensive issue and would be a question for a jury to decide. Factors to consider include the advertisement’s target audience; whether the accused character possessed any one actor’s physical characteristics, voice, gestures or mannerisms; whether the background included any setting recognizable from any one particular Bond movie that might evoke the corresponding actor. In this case it may be that the public has accepted the Bond character as generic and has ceased to associate it with any one actor.252

A final question arises when a portion of an original work is excised and reused to create something new. Is the new product privileged or prohibited? Where the work is not used for its original entertainment purposes, but is instead used for promoting a product, the use should be prohibited. For example, a clip from the *Star Trek* episode “Amok Time” depicting Spock intoning the Vulcan maxim, “Live long and prosper,” could not be used to promote the latest fad in herbal supplements without first obtaining Nimoy’s permission. However, the same clip could be used in a “Best of Star Trek” production.

V. CONCLUSION

The right of publicity invests a celebrity with exclusive control of the commercial exploitation of the celebrity’s identity to promote a

252. Note, however, that the original author of the “James Bond” character, or his heirs, might have a claim for misappropriation. Whether or not a character can be protected independently of the work in which it originated will depend, in part, on whether it has been sufficiently developed to the extent that it remains distinct and recognizable when excised from the trappings of the story, setting, and other characters. See Olson v. Nat’l Broad. Co., 855 F.2d 1446, 1451–53 (9th Cir. 1988) (discussing copyright protection for individual characters); Warner Bros. Pictures, Inc. v. Columbia Broad. Sys., 216 F.2d 945, 950 (9th Cir. 1954) (“if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright”); MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.12 (release no. 36, 1994).
product. Recent case law demonstrates that “appropriation of identity” is the correct standard by which to judge infringement under publicity rights and supports the premise that commercial exploitation of a fictional character that is closely associated with a celebrity is an indicia of identity.

This note supports the proposition that a federal right of publicity statute is necessary to harmonize widely varying state laws. This note also contends that any such statute should address infringement via prohibited use of a fictional character and suggests an analytical framework to determine infringement.

However, celebrities’ interests in their identities must yield to any fair use defense, including news, commentary, and entertainment, as well as advertising to promote any fair use.